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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,186	05/23/2000	Kia Silverbrook	NPA020US	9156

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

JUNG, DAVID YIUK

ART UNIT PAPER NUMBER

2134

MAIL DATE DELIVERY MODE

06/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/575,186	SILVERBROOK ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	David Y. Jung	2134

*– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –*  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-3,5-28 and 32-45 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3, 5-28, 32-45 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_.

## **DETAILED ACTION**

### **CLAIMS PRESENTED**

Claims 1-3, 5-28, 32-45 are presented.

#### ***Art Not Relied Upon***

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background. In particular, Patent Office notes US Patent 5692073 (Cass), cited by Applicant, especially figure 21 and column 17.

#### ***Response to Arguments***

Applicant's arguments filed have been fully considered but they are not persuasive. While the amendment and arguments regarding Johnson has clarified Applicant's position regarding Johnson, the Office respectfully requests further arguments regarding Sekendur.

For example, regarding Johnson, Applicant stated that Johnson does not teach the "location" and "superimposing" of graphic information as in the claims. Even if (assuming arguendo) this is true, Sekendur clearly teaches such location and graphic information handlings (as somewhat seems noted in Applicant's discussion of Sekendur). See, for instance, the coded data mentioning the coordinates and position data. As for "a plurality" of tags (rather than what Applicant assumes to be only a single tag of Johnson), Sekendur teaches "a plurality of coded data" mentioning

coordinates and position data. Thus, a combination of the teachings of Sekendur and teachings of Johnson teaches "a plurality of coded data tags."

For these reasons, Applicant's arguments are unpersuasive unless further amendments/arguments are provided.

## **CLAIM REJECTIONS**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-28, 32-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda (cited by Applicant, Abstract of Japan Patent Application number 08305112), Johnson (cited by Applicant, European Patent Application number 91304880.7, Publication number 0459793A1), and Sekendur (cited by Applicant, WIPO PCT International Application Number PCT/US/95/16913, International Publication Number WO 97/22959).

Regarding claim 1, Ikeda teaches a "photo album." See solution section (i.e. album editor 1 using photograph data).

Ikeda is not explicit about other features.

Johnson teaches "A method of enabling the creation and use of a ... via at least one ... form printed on a surface, the ... form containing graphic information relating to a ... activity and ... tags, each ... tag containing dot code identifying the ... form and the tag's own ...

on the ... form ...

said indicating data regarding the identity of the ... form (column 4, line 18 to column 6, line 39, i.e. forms which "facilitate proper location of markings" – e.g., column 6, line 34)."

Ikeda and Johnson are not explicit about other features.

Sekendur teaches "said graphic information being superimposed with a plurality of coded data... own location ...

the method comprising the steps of: receiving, in a computer system, indicating data from a sensing device operated by said user,

...

and a position of the sensing device relative to the ... form, the sensing device, when placed in an operative position relative to the ... form, generating the indicating data by sensing at least some of the dot code; and identifying in the computer system and from the indicating data, at least one parameter relating to the ... activity (page 4 to page 6, first paragraphs, i. e., position related cording means, writing surface, etc.)."

Ikeda (at Solution section) and Johnson (at column 6, line 34) and Sekendur (at first two paragraphs of page 3) all teach to combine the teachings with such other image handling devices for the motivation of providing ease for the user.

It would have been obvious at the time of the claimed invention to combine teachings of Ikeda, Johnson, Sekendur so as to teach the claimed invention for the motivation noted in the previous paragraphs.

Regarding claim 26, Ikeda teaches a "photo album." See solution section (i.e. album editor 1 using photograph data).

Ikeda is not explicit about other features.

Johnson teaches "A system for enabling the creation and use of a ... via at least one ... form printed on a surface, the ... form containing graphic information relating to a ... activity and including a plurality of tags, each tag containing a dot code identifying the ... form and a location of that tag on the ... form (column 4, line 18 to column 6, line 39, i.e. forms which "facilitate proper location of markings" – e.g., column 6, line 34)."

Ikeda and Johnson are not explicit about other features.

Sekendur teaches "said system comprising:

"a computer system for receiving indicating data from a sensing device operated by a user involved in the ... activity; said indicating data regarding the identity of the ... form and a position of the sensing device relative to the ... form, the sensing device, when placed in an operative position relative to the ... form, sensing the indicating data using at least some of the dot code, said computer system including means for identifying, from the indicating data, at least one parameter relating to the ... album activity (page 4 to page 6, first paragraphs, i. e., position related cording means, writing surface, etc.)."

Ikeda (at Solution section) and Johnson (at column 6, line 34) and Sekendur (at first two paragraphs of page 3) all teach to combine the teachings with such other image handling devices for the motivation of providing ease for the user.

It would have been obvious at the time of the claimed invention to combine teachings of Ikeda, Johnson, Sekendur so as to teach the claimed invention for the motivation noted in the previous paragraphs.

Regarding claims 2-3, 5-25, 27-28, 32-45, the limitations specific to these claims have been discussed in the previous Office Actions. For the reasons stated therein, these claims are not patentable.

***Points of Contact***

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or  
"DRAFT")

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to David Jung whose telephone number is (571) 272-3836  
or Kambiz Zand whose telephone number is (272) 272-3811.

David Jung

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Patent Examiner

5/31/07